

**THIS DISPOSITION
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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

9/20/00

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Opposition No. 112,680

Compact Disc World, Inc.

v.

Artistic Visions, Inc.

Before Seeherman, Chapman, and Holtzman, Administrative
Trademark Judges.

By the Board:

An application has been filed by Artistic Visions, Inc.
for "computerized on-line retail services in the field of
music, compact discs and audio cassettes featuring music,
movies, music videos, digital video disks (DVD) players and
related accessories for the foregoing, namely, carrying and
storage cases for the aforesaid goods, and headphones" in
class 35,¹ for the mark shown below:

CDworld

Compact Disc World, Inc., has filed an opposition
claiming priority of use and ownership of Registration No.
1,582,010, for COMPACT DISC WORLD, for "retail store sales

¹ Serial No. 74/646,399, filed March 14, 1995, alleging a date
of first use and first use in commerce of December 16, 1994.

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of compact discs, audio cassettes, records, audio components and accessories, compact discs video, laser disc and video tapes".² Opposer alleges that applicant's mark, "CDworld",³ when used in connection with the identified services, is likely to cause confusion, mistake, or deception.

Applicant, in its answer, denies the salient allegations of the notice of opposition.

This case now comes up on opposer's motion for summary judgment filed July 9, 1999.⁴ In support of its motion, opposer has submitted the affidavit of David C. Lang, opposer's president, who avers that opposer has used its mark in connection with retail stores since 1986; that the mark COMPACT DISC WORLD has been registered since 1990, and that opposer has submitted a status and title copy of Registration No. 1,582,010; that opposer has used "CD World" in many of its print and radio advertisements, copies of which have been submitted, and Mr. Lang uses this term in

² Reg. No. 1,582,010 issued on February 6, 1990, Section 8 affidavit accepted, with "compact disc" disclaimed. (Opposer also pleaded ownership of two additional registrations, Reg. No. 1,582,018, and Reg. No. 1,593,564, for COMPACT DISC WORLD and design, which have been cancelled under Section 8).

³ In order to approximate the commercial impression of the stylized drawing of applicant's mark, we have departed from our usual practice of reproducing trademarks in all capital letters, and have depicted it as "CDworld."

⁴ On April 19, 2000, opposer filed a motion to supplement its evidence in support of its motion for summary judgment. Opposer sought to introduce newly discovered evidence that a customer at one of its stores presented two of applicant's gift certificates on April 9, 2000. Because opposer's motion is unopposed and

his conversations with customers; and that music compact discs are very often referred to as "CDs". In further support of this point, Mr. Lang submitted definitions from two dictionaries showing "CD" is an abbreviation for "compact disc". Mr. Lang also testified that it is not unusual for retailers to market their goods in stores as well as over the Internet and that opposer established its own Internet site in 1998. In connection with this testimony he submitted print-outs from the Internet of four different retail music store businesses, namely, Tower Records, J & R Music World, Blockbuster and Borders, in which they offer for sale, through the Internet, videos, compact discs, and video and audio equipment. Finally, Mr. Lang states that actual confusion stemming from applicant's use of "Cdworld" has occurred because (i) he received four items of mail from record producers addressed to him at CD WORLD, rather than COMPACT DISC WORLD; (ii) a web server on the Internet has associated opposer's store locations with applicant's Internet address; and (iii) in response to interrogatory number 12, applicant stated that "in the years 1996-97, Applicant received 2 or 3 e-mail messages questioning whether Applicant would give the sender a discount on products like given in the store." A further declaration from Veronica Geyer, one of opposer's retail

well-taken as newly discovered evidence, it is hereby granted. Trademark Rule 2.127(a).

managers, was submitted wherein she avered that gift certificates which appeared to be printed from applicant's web site were presented for redemption at one of opposer's stores.

In opposing the motion, applicant submitted the declaration of its president, Bruce Pettyjohn, who avers, inter alia, that when applicant's application was examined by the Patent and Trademark Office, opposer's registration was not cited against it; that it is Mr. Pettyjohn's understanding that although opposer did not provide documents relating to its "annual gross dollar sales", it is Mr. Pettyjohn's belief, based on a print-out from a Dun & Bradstreet report that discloses annual sales for COMPACT DISC WORLD, INC., that opposer has received "many tens of millions of dollars in revenue from its use of its COMPACT DISC WORLD mark during the last four (4) years." Thus, in its brief applicant argues that considering the amount of advertising and sales of each party over the years,⁵ the alleged instances of confusion are de minimis and "can not [sic] be considered to establish a likelihood of confusion as a matter of fact for granting summary judgment."

⁵ Applicant's answer to interrogatory number 4 states that first use of its mark on "Internet site live and demo occurred on or about December 31, 1994." Applicant's answer to interrogatory number 6 describing the type of service offered under the mark states "Internet retail sales first demo on or about December 31, 1994, and first sales on or about April 1, 1995, for CDs, movies, video games, audio books, cassettes, laser discs and music videos".

(Applicant's brief p. 8). Finally, applicant argues in its brief that "while the meanings of the respective marks may be the same, the appearance and sound of the marks are drastically different...". (Applicant's brief p. 6).

A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c). See also, Celotex Corp. v. Catrett, 477 U.S. 317 (1986). When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact and that the moving party is entitled to judgment, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must offer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. See Fed. R. Civ. P. 56(e), and Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). In a motion for summary judgment, the evidentiary record and all reasonable inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party. See Lloyd's Food Products Inc. v. Eli's Inc., 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

Based on the submissions of the parties, we find that there are no genuine issues of material fact, and that opposer is entitled to judgment as a matter of law.

Priority is not in issue because opposer has made of record a status and title copy of its pleaded Registration No. 1,582,010 for COMPACT DISC WORLD for retail store services. This document, prepared by the Patent and Trademark Office, shows that the registration is valid and that opposer is the owner. Moreover, there is no genuine issue that opposer began using the mark COMPACT DISC WORLD for retail store services in 1986, long before applicant's first use in 1994.⁶

Turning to the issue of likelihood of confusion, we are guided by the factors set forth in the case of In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).

Applicant's mark is "CDworld" and opposer's mark is COMPACT DISC WORLD. There is no genuine issue that CD is an abbreviation for COMPACT DISC. Further, opposer has shown that customers refer to it by the abbreviated phrase CD WORLD. Thus, both marks consist of the equivalent terms CD or COMPACT DISC, which are generic for the goods the parties sell, followed by the identical word WORLD, which is the only distinguishing term in both marks. When the marks are

⁶ See footnote 5 *supra*.

compared in their entireties, they are similar in appearance and pronunciation, and identical in connotation and commercial impression.

With respect to the services, there is no genuine issue that the parties sell the same type of goods. Both applicant's identification in its application and opposer's registration list, inter alia, compact discs and audiocassettes. The only difference in the services is that opposer's registration identifies its services as being rendered through retail stores, and applicant's are identified as being rendered on-line. However, there is no genuine issue that these are related services. Opposer has submitted evidence that four third parties offer both retail store and on-line retail services in the field of compact discs and the like. As a result, consumers familiar with the sale of compact discs and the like in retail stores under the mark COMPACT DISC WORLD are likely, upon seeing the highly similar mark "CDworld" for computer on-line retail services for compact discs and the like, to believe that both services emanate from a single source.

Further, we note that opposer has itself expanded into Internet sales, although it did so subsequent to applicant's adoption of its mark.⁷ In addition to sales, opposer uses

⁷ Applicant argues that it is necessary for opposer to have expanded into on-line sales through the Internet at the time applicant first began to use its mark for Internet sales in order to establish that the services are related. However, it

its Internet site to advertise sales at its stores, and to provide customers information on newly released recordings and information on how to order by mail.⁸ Further opposer's URL address appears in its in-store newspaper (see Exhibit E to Mr. Lang's declaration filed in support of its reply brief).

There is no genuine issue that opposer's and applicant's services are offered to the same class of consumers, i.e., the general public who purchase music and music related items. There is also no genuine issue that the purchasers are not sophisticated, and that the items sold by both parties are impulse, relatively inexpensive purchases, as shown by the fact that applicant's Internet site offers compact discs for \$12.47. (Opposer's brief p. 21). Such consumers, obviously, would not exercise a great degree of care in shopping retail stores or on-line for the goods sold through the parties' respective services.

is not necessary for opposer to prove prior use in connection with Internet sales in order to show the relatedness of the services. See Mason Engineering and Design Corporation v. Mateson Chemical Corporation, 225 USPQ 956, 962 (TTAB 1985) (the first user of a mark in connection with particular services possesses superior rights in the mark against subsequent users of the same or similar mark for any goods or services which purchasers might reasonably expect to emanate from it in the normal expansion of its business under the mark, whether or not the first user of the mark has actually expanded its use of its mark, after the commencement of the subsequent user's use, to services which are the same as or closely related to those of the subsequent user).

⁸ Affidavit of David Lang, par. 16.

Opposer has argued, in terms of the duPont factor of fame, that during the more than twelve years it has used its mark, it has spent a substantial amount of money for advertising and establishing name recognition of the mark with consumers. In particular, opposer asserts that from 1995 until Mr. Lang's affidavit was signed in July 1999, it spent over \$3.4 million in advertising.⁹ The evidence submitted by opposer does not establish the fame of its mark and, in reaching our decision that confusion is likely, we have not considered fame as a factor in opposer's favor.

Nor have we given weight to opposer's evidence of alleged instances of actual confusion. As indicated previously, in determining a motion for summary judgment, all inferences must be viewed in the light most favorable to the nonmoving party. Drawing such inferences in applicant's favor, we cannot say that opposer has established actual confusion. However, the lack of evidence of actual confusion does not mean that opposer is not entitled to judgment. The statute prohibits the registration of marks that are likely to cause confusion, and it is unnecessary to show actual confusion to establish a likelihood of confusion. See Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

⁹ Lang affidavit, par. 17.

Applicant also asserts that opposer's mark was not cited against applicant's application during the ex parte examination process as support for its position that confusion between the parties' marks is not likely. We cannot determine whether the examining attorney was even aware of opposer's registration, let alone what his reasons might have been for not citing it. In any event, the fact that the examining attorney did not cite opposer's registration as a basis for refusal on the ground of likelihood of confusion is not binding on the Board. If it were, there would be no point in allowing any oppositions to be brought on the basis of a registered mark.

Based on the record before us, we find that there is no genuine issue of material fact and that opposer is entitled to judgment as a matter of law. Accordingly, opposer's motion for summary judgment is granted, the opposition is sustained, and registration to applicant is refused.

E. J. Seeherman

B. A. Chapman

T. E. Holtzman

Administrative Trademark
Judges, Trademark Trial
and Appeal Board